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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

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Ko ONODERA, et al.

: EXAMINER: LAMB, B

SERIAL NO: 09/820,846

:

FILED: MARCH 30, 2001

: GROUP: 1734

FOR: TERMINAL ELECTRODE FORMING METHOD
IN CHIP-STYLE ELECTRONIC COMPONENT
AND APPARATUS THEREFOR

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Restriction Requirement stated in the Official Action dated October 7, 2002, Applicants provisionally elect Group (Invention) I, Claims 1-5, drawn to a method, classified in class 427, subclass 79.

Applicants respectfully traverse the outstanding Restriction Requirement for several reasons.

First, the outstanding Office Action asserts that Inventions I and II are distinct each from the other under MPEP §806.05(e), because "... the process as claimed can be used to practice another and materially [different] apparatus such as one wherein the peeling step is performed by hand and only one drying unit is required instead of the two drying units required by the apparatus," while "[t]he apparatus as claimed can be used to practice another and materially [different] process such as one wherein paste in the coating flat bed has

different degrees of thickness to enable one to apply different amounts of conductive paste on different chip components." However, without further information, such a finding lacks grounds upon which it can be evaluated whether in fact the alleged alternatives are "materially different" under MPEP §806.05(e). Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP §803 states the following:

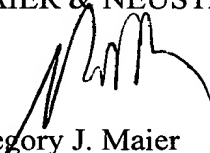
If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In the present application, Claim 1 is directed to a thermal electrode forming method, while Claim 6 is directed to a terminal electrode forming apparatus. Hence, it appears that the claims in the present application are part of an overlapping search area and that a search for Claims 1-5 would necessarily include the class and subclass required for a search directed to Claims 6-15 as well. It is therefore believed that there is no undue burden on the Examiner to search all the claims under MPEP §803, and Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-15 be conducted.

Respectfully submitted,

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